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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,358	06/30/2004	Aki Kobayashi	042276	2290

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EXAMINER

CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/500,358	Applicant(s) KOBAYASHI ET AL.	
	Examiner Yong S. Chong	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on 10/19/2005. Claims 13-18 have been added. Claims 13-18 have been withdrawn. Claims 1-12 have been amended. Claims 1-18 are pending. Claims 1-12 are examined herein.

Newly submitted claims 13-18 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 13-18 are directed to methods of use as opposed to claims 1-12 that were examined as claims directed to a composition.

Unity of invention links the various inventions together by sharing a common special technical feature in each invention. However, when the special technical feature is not a contribution over the prior art, the various inventions may be restricted from each other. In the instant case, unity of invention does not exist because the special technical feature is disclosed by Clarkson, Roetker, and Jensen et al. Therefore, restriction between composition and method claims is proper. See MPEP 1850 and 37 CFR 1.475.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Thus, claims 13-18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Claims 4-9 stand rejected under 35 USC 102(b) as being anticipated by Roetker et al. (US Patent 5,630,847) for reasons of record. Applicant's arguments have been fully considered and found persuasive to withdraw the said rejection for claims 1-3. In particular, applicant has overcome the rejection by removing 1,2-octanediol for claim 1 and removing eugenol for claims 2-3.

In light of applicant providing an English translation of JP 2002-281678, the remaining rejections, 35 USC 102(e) and 103(a), based on Ono et al. will be withdrawn as it no longer qualifies as prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham vs John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 1-12 are rejected under 35 U.S.C. 103(a) as being obvious over Clarkson et al. (US Patent Application 2001/0036964 A1) in view of Roetker et al. (US Patent 5,630,847) and further in view of Jensen et al. (US Patent 2,550,255).

The instant claims are directed to a composition comprising 1,2-alkanediols and one or more materials selected from the group consisting of thymol, eugenol, citronella, terpinyl acetate, citronellol, and β -pinene.

Clarkson et al. teach an anti-microbial composition comprising polyhydric alcohol (abstract), where the preferred compounds are 1,2-hexanediol and 1,2-octanediol (section 0065). These compositions are used on the most malodorous areas of the body (section 0001), therefore requiring the use of perfumes or fragrances (section 0086).

However, Clarkson et al. fail to disclose specifically a perfume or fragrance or a food product containing this composition.

Roetker et al. teach a composition containing 1,2-octanediol (col. 2, lines 30-40) and a perfume ingredient such as eugenol (col. 6, line 4). This composition is exemplified in Example I.

Jensen et al. teach anti-bacterial agents to be employed as an effective preservative for food products (col. 1, lines 34-56).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the antimicrobial composition as taught by Clarkson et al. and Roetker et al. in food products.

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A person of ordinary skill in the art would have been motivated to use the composition taught by Clarkson et al. and Roetker et al. in food products because the anti-bacterial properties of 1,2-hexanediol and 1,2-octanediol can be used as a preservatives in food products to prevent spoilage and decomposition.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC


SHENGJUN WANG
PRIMARY EXAMINER